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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,682	07/07/2000	Pieter J. Van Zee	10003733-1	6939

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Hewlett-Packard Company
Intellectual Property Administration
P O Box 272400
Fort Collins, CO 80528-9599

EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/611,682

Applicant(s)

VAN ZEE ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-13, 15, 16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 16 and 18-26 is/are allowed.
- 6) ☐ Claim(s) 1-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **5/24/2004**.
2. This application has been reconsidered. Claims 1-13, 15, 16, and 18-26 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 7, 10, 11, 12, 13, and 15, are rejected under 35 U.S.C. 102(e) as being anticipated by Barad et al (Barad) (U.S. 6,206,750).

With respect to claims 1, 2, 11, 12, 13, and 15, Barad discloses issuing plural instructions to a requesting computer (column 5, lines 6-12) to render content (column 5, lines 13-65), the plurality of instructions including at least a subset (printing) which are interpreted to render an

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iconic selector (30) associated with a service (printing) (figure 11), wherein a user selection of the iconic selector generates a request to print content from the service (figure 11 and column 4, lines 10-15), and fulfilling the request without requiring further input from the user (column 7, lines 46-62).

With regard to claims 7 and 10, Barad discloses the iconic selector includes a network address associated with the content (which reads on using the icons to navigate within internet pages) (column 4, lines 10-15).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 7, 10, 11, 12, 13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Jakobson (U.S. 6,697,838).

With respect to claims 1, 2, 11, 12, 13, and 15, Jakobson discloses issuing plural instructions to a requesting computer (column 6, lines 34-66) to render content (column 4, lines 34-66), the plurality of instructions including at least a subset (printing) which are interpreted to render an iconic selector (134b) associated with a service (printing) (figure 2B), wherein a user selection of the iconic selector generates a request to print content from the service (figure 2B and column 6, lines 56-66), and fulfilling the request without requiring further input from the user (column 6, lines 56-66).

With regard to claims 7 and 10, Barad discloses the iconic selector includes a network address associated with the content (which reads on using the icons to navigate within internet pages) (column 6, line 56 to column 7, line 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 5, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barad in view of Reisman (U.S. 6,658,464).

With regard to claims 3, 4, 6, 8, and 9, Barad differs from claim 3, 4, 6, 8, and 9 in that he does not clearly disclose determining whether the requesting computer is populated with a

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content handler and downloading the content handler to the requesting computer if the requesting computer is not populated with the content handler.

Reisman discloses determining whether the requesting computer is populated with a content handler (column 7, lines 18-67) and downloading the content handler to the requesting computer if the requesting computer is not populated with the content handler (column 7, lines 18-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Barad by the teaching of Reisman in order to make the system more user friendly.

With respect to claim 5, Reisman discloses the downloading may be manually performed (column 8, lines 20-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Barad by the teaching of Reisman in order to give the user more control.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 4, 5, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakobson in view of Reisman (U.S. 6,658,464).

With regard to claims 3, 4, 6, 8, and 9, Jakobson differs from claim 3, 4, 6, 8, and 9 in that he does not clearly disclose determining whether the requesting computer is populated with a content handler and downloading the content handler to the requesting computer if the requesting computer is not populated with the content handler.

Reisman discloses determining whether the requesting computer is populated with a content handler (column 7, lines 18-67) and downloading the content handler to the requesting computer if the requesting computer is not populated with the content handler (column 7, lines 18-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Jakobson by the teaching of Reisman in order to make the system more user friendly.

With respect to claim 5, Reisman discloses the downloading may be manually performed (column 8, lines 20-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Jakobson by the teaching of Reisman in order to give the user more control.

Allowable Subject Matter

8. Claims 16 and 18-26 are allowed.

Response to Arguments

9. Applicant's arguments with respect to claims 1-13 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER

